

REMARKS

This Amendment is filed in response to the Final Office Action dated April 12, 2007, which has a shortened statutory period set to expire July 12, 2007.

General Comments

Claims 28 and 35 recite, "wherein the trigger condition disables a set of features of the CAD tool until the additional payment is made". The Examiner questions whether the Specification supports the limitations of Claims 28 and 35, but has decided not to object to or reject the claims on this basis. Applicant respectfully notes that the Specification does support these limitations.

Specifically, the Specification, page 8, lines 1-12, teaches that **enforcement of the additional payment can include denying use of the CAD tools to the designer**. Disabling could include, for example, not being able to generate certain output files, not being able to run certain CAD tools, etc. For example, if a designer has used the vendor's tools to generate a specific report, then when the designer asks the tool to print such a report, the tool may instead generate a request for the additional payment. Once the vendor receives payment, the vendor could, for example, manually enable the tool to print the desired report (assuming that the tool is on the designer's server with no monitoring capability) or automatically enable the tool (assuming the vendor has access to the tool). Yet another technique could include an automated payment scheme that would make payment to the software vendor as part of a transaction that produces a result.

Notably, once the features are disabled (which seems easily done), then the designer has an incentive to pay quickly,

thereby hastening the enabling of those features (e.g. the printing of the report). Thus, the vendor is not at the mercy of the designer, as characterized in the Final Office Action.

Claims 26-40 Are Patentable Over Robertson

Claim 26 recites in part:

using the CAD tool, wherein the computer system running the CAD tool includes criteria for requesting at least one additional payment for the CAD tool, each additional payment being associated with generating an output, the computer system being responsive to one or more trigger conditions corresponding to the criteria; and

receiving a payment request when an output generated by the CAD tool satisfies a trigger condition, wherein the trigger condition adds a watermark to the output for identifying the output as having been produced by the CAD tool.

The Final Office Action states that the portal site of Robertson may facilitate purchase, lease, or other acquisition (which may include pay-per-use or pay by installment based on a contract or agreement) of the tools and services offered through it. Applicant traverses this characterization. Specifically, the embodiments taught by Robertson do not teach a pay-per-use plan or a pay-by-installment plan. None of the passages cited by the Final Office Action (i.e. the Abstract, FIGS. 3-5, 7-10; col. 1, lines 35-54; col. 2, lines 12-24, 40-54; col. 4, lines 49-61; and col. 4, line 64 to col. 5, line 28) teach a pay-per-use or pay-by-installment plan. Indeed, because Robertson does not teach a pay-per-use or a pay-by-installment plan, Robertson does not recognize the advantages of using a **watermark added to the output as a trigger for requesting additional payment for a CAD tool**.

Instead, Robertson uses a watermark merely to protect an IP core when it is electronically delivered to the user via the

portal site. Col. 18, lines 41-58. Robertson fails to make any suggestion that a watermark can be used to **trigger an additional payment based on an output of a CAD tool including the watermark.**

Robertson does teach that the portal site can deduct a transaction fee from a user payment before sending the remainder of the user payment to the provider of the IC fabrication service. See, e.g. Claims 10 and 11. However, this transaction fee also fails to teach a pay-per-use or pay-by-installment plan.

The Final Office Action admits that Robertson fails to teach the above-quoted limitations relating to using the CAD tool and receiving the payment request. However, the Final Office Action then cites Official Notice/common practice in obviating criteria for requesting an additional payment based on generating an output using the CAD tool and receiving a payment request based on the trigger condition, which is identified by a watermark in the output. Applicant appreciates the Examiner's examples of "outputs" including watermarks, thereby providing support for his Official Notice/common practice rejection. However, Applicant respectfully submits that such examples are clearly distinguished from the present invention.

Specifically, the Final Office Action states that it is common practice to watermark a dollar bill, software, or a video to guarantee product integrity or prevent fraud. Applicant appreciates these uses of watermarks. **However, the use of the watermark in the present invention is quite different. That is, the watermark is added to the output to "identify the output as having been produced by the CAD tool". Moreover, this watermark then triggers a payment request, which is not the case for any of the "common practice" watermarks.**

As noted above, Robertson uses a watermark to **protect** an IP core when it is electronically delivered to the user via the portal site. Col. 18, lines 41-58. Thus, Robertson uses a watermark in a manner that conforms to the Examiner's "common practice" watermarks. However, **as evidenced by the lack of disclosure in Robertson, it is not common practice in the CAD industry to negotiate a payment installment plan or payment schedule for a CAD tool, much less generate a request for an additional payment, which is triggered by a watermarked output of the CAD tool.** Therefore, even when common practice/Official Notice and Robertson are combined, the recited steps of using and receiving are not disclosed or suggested. Based on the above reasons, Applicant requests reconsideration and withdrawal of the rejection of Claim 26.

Claims 27-32 depend from Claim 26 and therefore are patentable for at least the reasons presented for Claim 26. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claims 27-32.

Claim 33 recites:

entering criteria for requesting at least one additional payment for the CAD tool into a computer system running the CAD tool, each additional payment being associated with the CAD tool generating an output, the computer system being responsive to one or more trigger conditions corresponding to the criteria; and

generating a payment request when an output generated by the CAD tool satisfies a trigger condition.

Therefore, Claim 33 is patentable for substantially the same reasons presented for Claim 26. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claim 33.

Claims 34-39 depend from Claim 33 and therefore are patentable for at least the reasons presented for Claim 33.

Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claims 34-39.

Claim 40 recites:

running the CAD tool on a computer system, the CAD tool specifying a trigger condition for requesting a second payment, the first and second payments representing a purchase price related to the CAD tool and specified by the contract, the trigger condition including producing the output data file using the CAD tool;

producing the output data file by the CAD tool user using the CAD tool, wherein the CAD tool automatically adds a watermark to the output data file to identify the output data file as having been produced with the CAD tool, wherein the watermark includes at least one of a naming convention, non-functional data, a spacing convention, and an ordering convention that indicates the trigger condition, wherein the computer system automatically detects the watermark; and

upon detection of the watermark, receiving a request for the second payment by the CAD tool user in accordance with the contract.

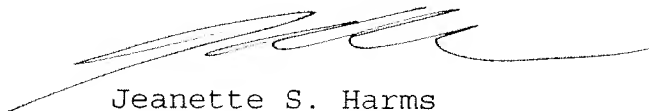
Therefore, Claim 40 is patentable for substantially the same reasons presented for Claim 26. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claim 40.

CONCLUSION

Claims 26-40 are pending in the present application.
Allowance of these claims is respectfully requested.

If there are any questions, please telephone the
undersigned at 408-451-5907 to expedite prosecution of this
case.

Respectfully submitted,



Customer No.: 35273

Jeanette S. Harms
Attorney for Applicant
Reg. No. 35,537